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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,189	11/20/2003	Tsutomu Okada	17272	9810
23389	7590	11/04/2005	EXAMINER	
SCULLY SCOTT MURPHY & PRESSER, PC			VRETTAKOS, PETER J	
400 GARDEN CITY PLAZA				
SUITE 300			ART UNIT	PAPER NUMBER
GARDEN CITY, NY 11530			3739	

DATE MAILED: 11/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/718,189	OKADA, TSUTOMU	
	Examiner	Art Unit	
	Peter J. Vrettakos	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 09 June 2004.

2a) This action is FINAL.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-32 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-32 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6-9-04.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## DETAILED ACTION

**Claims 1-32 are pending.**

**The claims appear to be mere translations from the related Japanese application, making examination relatively difficult. See the rejection immediately below.**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10-13 and 26-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claims 10 and 26 recite that the elongated member includes a cylindrical member having a tip end disposed in a position **distant** from the electrode. However, claims 1 and 17 (from which claims 10 and 26 depend) claim an electrode disposed **on** the tip end portion of the elongated member. So the following question begs to be asked. Is the tip end **distant** from the electrode as in dependent claims 10 and 27, or is the electrode disposed **on** the tip end as in independent claims 1 and 17?

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Maslanka (4,503,855).

Maslanka discloses a diathermic cutter (figure 1) with a main body member/sheath (1), an elongated electrically conductive member (3,11), an electrode (5,21) with an exposed base end surface (21 – Office contends this is part of the electrode because 5 and 21 are electrically continuous) and an insulating member (23).

2. Claims 1 and 3-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Kittur et al. (5,846,241).

Kittur discloses a diathermic cutter (figure 1) comprising a main body/sheath (12), electrically conductive (“second wire”, col. 2:62) concentrically disposed (see figures 2, 3a, 3b) elongated coated (col. 3:26-27) member (20), electrode (24) with an exposed side portion (depicted in figure 1), electrically insulating member (25) with a circular arc shape (figs 1, 5a, 8) representing a “second cylindrical member” if 20/24 (which constitutes one electrode member) represents a “first cylindrical member”, and an insulating lip (50, figure 8). Note: in figure 8, the electrode (24) is exposed to a side surface of the electrically insulating member (25+50). In figure 5a, the electrode (24) is exposed to the outside (space) from a side surface of the insulating member (25).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 2-5, 17-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kittur et al. in view of Ryan (5,366,463).

Ryan discloses in a structurally analogous invention, an electrically insulting member (78, figure 5) connected to the tip end of the sheath (72). Also note that the elongated member (73) in Ryan is electrically insulated with respect to metallic element 74, which is analogous to the electrode 24.

Therefore, at the time of the invention it would have obvious to one of ordinary skill in the art to modify Kittur in view of Ryan by including as a design expedient an insulating member at the tip end of a sheath in a diathermic cutter. The motivation is found in Ryan col. 7:30-38, which is to permit "proper relative placement and alignment between the tip (see figure 5, 71 in Ryan) and the base (72 in Ryan).

***Conclusion***

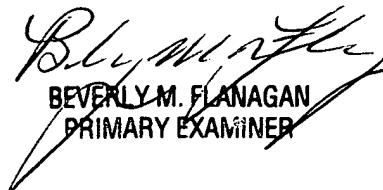
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rydell (5,085,659)(5,171,255), Ouchi (6,190,384), Wappler (1,908,583).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J. Vrettakos whose telephone number is 571-272-4775. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pete Vrettakos  
October 30, 2005

  
BEVERLY M. FLANAGAN  
PRIMARY EXAMINER